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| 09/834,264 | 04/12/2001 | Rahav Yairi | 5288.00005 | 2757 |

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|---|---|---|

BANNER & WITCOFF
1001 G STREET N W
SUITE 1100
WASHINGTON, DC 20001

| EXAMINER |
|---|
| PATEL, ASHOKKUMAR B |

| ART UNIT | PAPER NUMBER |
|---|---|
| 2154 | |

DATE MAILED: 09/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

| | Application No. | Applicant(s) |
|---|---|---|
| **Office Action Summary** | 09/834,264 | YAIRI, RAHAV |
| | Examiner | Art Unit | |
| | Ashok B. Patel | 2154 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1)☒ Responsive to communication(s) filed on *15 July 2005*.

2a)☒ This action is **FINAL**.  2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

4)☒ Claim(s) *1-13* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-13* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

## Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All  b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

## DETAILED ACTION

1.     Application Number 09/834, 264 was filed on 04/12/2001.  Claims 1-13 are

subject to examination.

### *Response to Arguments*

2.     Applicant's arguments filed  07/15/2005 have been fully considered but they are

not persuasive for the following reasons:

**Claim rejection under 102(b):**

**Applicant's argument:**

"Independent claim 1, includes the feature of "comparing the destination. address

to the main and at least one alias electronic mail addresses." Applicant respectfully

submits that Agraharam never performs this step. All of the email that arrive at the

translation server in Agraharam is addressed to the phone number and all email that

arrives at the email server is addressed to the email address. There is no need in

Agraharam to perform the step of "comparing the destination address to the main and at

at least one alias electronic  mail addresses."

"Claim 3 has been amended by this paper to include the step of "comparing a

destination address of an electronic mail message to the main electronic mail address

and the at least one alias electronic mail address." Similar to the above remarks

regarding independent claim 1, Applicant respectfully submit that this claimed feature of

independent claim 3 is not disclosed in Agraharam."

"Independent claims 10, 12 and 13 each contain a similar feature of "**comparing**

the destination address to addresses included **in a database of main and alias**

**electronic mail addresses**." As discussed above, Agraharam does not disclose,

teach, or suggest this claimed feature."

**Examiner's response:**

First of all, claim 1 recites "receiving at a mail server an electronic mail message

having a destination address", as previously indicated, this destination address is, as

taught by Agraharam in col. 4, lines 44-47,"At step 201, the sender transmits an e-mail

message to a user or group of users using each recipient's telephone#@domain.sub. --

name."

Now, Agraharam goes on teaching in col. 3, line 51-66, "Once the recipient has

registered with translation server 110, an e-mail message addressed to the alias

address of that recipient is directed to translation server 110. For example, an e-mail

message from a sender at client terminal 101 addressed to 2015558765@email.att.net

is forwarded to translation server 110. Translation server 110, running a standard and

well known Sendmail Daemon program, uses the telephone number address identity,

2015558765, to access database 117. Using that telephone number alias name,

server 110 retrieves from database 117 the actual e-mail address associated with that

telephone number and the Sendmail Daemon forwards the received e-mail message to

that recipient's actual e-mail address. Thus, in the example, the e-mail message

addressed to 2015558765@email.att.net is forwarded by server 110 to its

corresponding actual e-mail address of steveg@attmail.com."

The processes of retrieving from database the actual e-mail address (the main)

associated with that telephone number (at least one of alias) inherently includes

"comparing the destination address to the main and at least one alias electronic mail

addresses."

<u>This inherent fact that the processes of retrieving from database includes</u>

<u>"comparing" is further substantiated by the claims 10, 12 and 13 of the instant</u>

<u>application as underlined above.</u>

### *Response to Amendment*

3.    The amendment to the claims filed on 07/15/05does not comply with the

requirements of 37 CFR 1.121(c) because claim 4 is not indicated as being "(currently

amended)". Amendments to the claims filed on or after July 30, 2003 must comply with

37 CFR 1.121(c) which states:

(c) *Claims.* Amendments to a claim must be made by rewriting the entire claim with all changes (*e.g.,* additions and deletions) as indicated in this subsection, except when the claim is being canceled. Each amendment document that includes a change to an existing claim, cancellation of an existing claim or addition of a new claim, must include a complete listing of all claims ever presented, including the text of all pending and withdrawn claims, in the application. The claim listing, including the text of the claims, in the amendment document will serve to replace all prior versions of the claims, in the application. In the claim listing, the status of every claim must be indicated after its claim number by using one of the following identifiers in a parenthetical expression: (Original), (Currently amended), (Canceled), (Withdrawn), (Previously presented), (New), and (Not entered).
        (1) *Claim listing.* All of the claims presented in a claim listing shall be presented in ascending numerical order. Consecutive claims having the same status of "canceled" or "not entered" may be aggregated into one statement (*e.g.,* Claims 1–5 (canceled)). The claim listing shall commence on a separate sheet of the amendment document and the sheet(s) that contain the text of any part of the claims shall not contain any other part of the amendment.
        (2) *When claim text with markings is required.* All claims being currently amended in an amendment paper shall be presented in the claim listing, indicate a status of "currently amended," and be submitted with markings to indicate the changes that have been made relative to the immediate prior version of the claims. The text of any added subject matter must be shown by underlining the added text. The text of any deleted matter must be shown by strike-through except that double brackets placed before and after the deleted characters may be used to show deletion of five or fewer

consecutive characters. The text of any deleted subject matter must be shown by being placed within double brackets if strike-through cannot be easily perceived. Only claims having the status of "currently amended," or "withdrawn" if also being amended, shall include markings. If a withdrawn claim is currently amended, its status in the claim listing may be identified as "withdrawn—currently amended."

(3) *When claim text in clean version is required.* The text of all pending claims not being currently amended shall be presented in the claim listing in clean version, *i.e.*, without any markings in the presentation of text. The presentation of a clean version of any claim having the status of "original," "withdrawn" or "previously presented" will constitute an assertion that it has not been changed relative to the immediate prior version, except to omit markings that may have been present in the immediate prior version of the claims of the status of "withdrawn" or "previously presented." Any claim added by amendment must be indicated with the status of "new" and presented in clean version, *i.e.*, without any underlining.

(4) *When claim text shall not be presented; canceling a claim.*

(i) No claim text shall be presented for any claim in the claim listing with the status of "canceled" or "not entered."

(ii) Cancellation of a claim shall be effected by an instruction to cancel a particular claim number. Identifying the status of a claim in the claim listing as "canceled" will constitute an instruction to cancel the claim.

(5) *Reinstatement of previously canceled claim.* A claim which was previously canceled may be reinstated only by adding the claim as a "new" claim with a new claim number.


## *Claim Rejections - 35 USC § 102*

4.      The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.


5.      Claims 1-13 are rejected under 35 U.S.C. 102(b) as being anticipated by Agraharam et al. (hereinafter Agraharam) (US 5, 987, 508).

**Referring to claim 1,**

The reference teaches a method of routing electronic mail messages to a user with a

server (Fig. 1, element 110), the method comprising the steps of:

(1) receiving at a mail server an electronic mail message having a destination address

(col. 4, lines 44-47,"At step 201, the sender transmits an e-mail message to a user or

group of users using each recipient's telephone#@domain.sub. -- name.");

(2) receiving from a user at the mail server an identification of a main electronic

mail address and at least one alias electronic mail address (col. 3, lines 35-50);

(3) comparing the destination address to the main and at least one alias

electronic mail addresses; and (4) transmitting the electronic mail message to an

address determined as a result of the comparing step (col. 3, line 51-66).

**Referring to claim 2,**

The reference teaches the method of claim 1, wherein step (4) comprises:

transmitting the electronic mail message to the destination address when the

destination address is indicated as a main address; and

transmitting the electronic mail message to a main address when the destination

address is indicated as an alias address corresponding to the main address. (col. 3, line

51-66)

**Referring to claim 3,**

The reference teaches a method of providing an electronic mail service to users, the

method comprising the steps of: (1) registering a main electronic mail address for a

user; (2) providing at least one alias electronic mail address to the user; (3) comparing a

destination address of an electronic mail message to the main electronic address and

the at least one alias electronic mail address; and (4) delivering electronic messages

addressed to the main address and electronic mail messages addressed to the at least

one alias address to a single electronic mail inbox. (col. 3, line 24-50)

**Referring to claim 4,**

The reference teaches the method of claim 3, further including the step of: (5) allowing

the user to manage the at least one alias electronic mail address. (col. 5, line 39

through col. 6, line 5)

**Referring to claims 5 and 6,**

The reference teaches the method of claim 4, wherein the allowing steps comprises

allowing the user to delete alias electronic mail addresses, and the method of claim 4,

wherein the allowing steps comprises allowing the user to add alias electronic mail

addresses. (col. 5, line 24 through col. 6, line 5, )

**Referring to claims 7 and 8,**

The reference teaches the method of claim 3, further including the step of providing a

record of electronic messages sent by and received by the at least one alias electronic

mail address. (col. 5, lines 30-37), and the method of claim 7, further including the step

of displaying electronic messages received by the at least one alias electronic mail

address. col. 5, line 24 through col. 6, line 5)

**Referring to claim 9,**

The reference teaches the method of claim 3, further including the step of providing the

main electronic mail address to the user. (col. 6, lines 6-22)

**Referring to claim 10,**

The reference teaches an electronic mail server configured to perform the steps of:

(1) receiving an electronic mail message having a destination address( col. 4,

lines 44-47,"At step 201, the sender transmits an e-mail message to a user or group of

users using each recipient's telephone#@domain.sub.-- name.");

(2) comparing the destination address to addresses included in a database of

main and alias electronic mail addresses (col. 3, lines 35-50); and

(3) transmitting the electronic mail message to an address determined as a result

of the comparing step (col. 3, line 51-66).

**Referring to claim 11,**

The reference teaches the mail server of claim 10, wherein step (3) comprises:

transmitting the electronic mail message to the destination address when the

destination address is indicated as a main address in the database; and transmitting the

electronic mail message to a main address when the destination address is indicated as

an alias address corresponding to the main address in the database. (col. 3, line 51-66)

**Referring to claim 12,**

Claim 12 is a claim to a computer-readable medium having computer-executable

instructions for performing the method steps of claim 1. Therefore claim 12 is rejected

for the reasons set forth for claim 1.

**Referring to claim 13,**

The reference teaches an electronic mail system comprising: an electronic mail server

(Fig. 1, element 110) configured to perform the steps of:

(1) receiving an electronic mail message having a destination address

( col. 4, lines 44-47,"At step 201, the sender transmits an e-mail message to a user or

group of users using each recipient's telephone#@domain.sub.-- name.");

(2) comparing the destination address to addresses included in a database of

main and alias electronic mail addresses; and (3) transmitting the electronic mail

message to an address determined as a result of the comparing step; and a computer

coupled to the electronic mail server and including computer executable instructions

that allow a user to send electronic mail messages from more than one electronic mail

address with a single user interface. (col. 3, lines 35-66, col. 5, lines 24-37)

### Conclusion

**Examiner's note:** Examiner has cited particular columns and line numbers in the

references as applied to the claims above for the convenience of the applicant.

Although the specified citations are representative of the teachings of the art and are

applied to the specific limitations within the individual claim, other passages and figures

may apply as well. It is respectfully requested from the applicant in preparing responses,

to fully consider the references in entirety as potentially teaching all or part of the

claimed invention, as well as the context of the passage as taught by the prior art or

disclosed by the Examiner.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time

policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later

than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Ashok B. Patel whose telephone number is (571) 272-

3972. The examiner can normally be reached on 8:00am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, John A Follansbee can be reached on (571) 272-3964. The fax phone

number for the organization where this application or proceeding is assigned is 703-

872-9306.

Information regarding the status of an application may be obtained from the

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Business Center (EBC) at 866-217-9197 (toll-free).

Abp
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JOHN FOLLANSBEE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100